

REMARKS

This application pertains to a redetachable self-adhesive film strip, having a grip tab which has a static frictional force  $F_s$ , as measured in accordance with DIN 53375, of at least 170 cN. Owing to the frictional force, the grip tabs can be held more securely when pulled on to stretch the adhesive film strip to break the adhesive bond.

Claims 1 to 10 are pending.

Claims 1-10 stand rejected under 35 U.S.C. 112, second paragraph, for various informalities, some of which are specifically mentioned in the Office Action. Applicant has reviewed all of the claims and made appropriate amendments to correct the informalities, including those mentioned by the Examiner.

With respect to Claim 8, however, Applicants believe that Markush language would be more cumbersome than the present alternative language and would prefer the present language. In this regard, it is respectfully pointed out that

*When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C, and D" is a proper limitation, then "wherein R is A, B, C, or D" shall also be considered proper. (See MPEP 2173.05(h), the relevant portion of which is annexed hereto).*

Applicants therefore request that the Examiner permit them to retain Claim 8

in its present form, and that the rejection of Claims 1-10 under 35 U.S.C. 112, second paragraph, be withdrawn.

The specification stands objected to and Claims 1-10 rejected under 35 U.S.C. 112, first paragraph, as the Examiner finds the Examples section set forth at pages 7 and 8 of the specification as not understood in its present form, with specific reference to the Table at page 8.

Those skilled in the art will understand that, among other advantages, the invention is directed towards overcoming the problem of tearing that has been associated with redetachment of redetachable adhesive strips in the past. See, for example, the discussion in the paragraph beginning at page 3, line 14. Those skilled in the art will also understand that the invention provides adhesive strips with grip tabs having a specified static frictional force, to avoid slipping when pulled, as discussed in the paragraph beginning at page 3, line 19.

Having read the above-mentioned paragraphs, as well as the discussion under the heading "Determination of behavior in a realistic redetachment process", at page 6 of the specification, those skilled in the art will understand that the experimental results found in the Tables set forth at pages 7 and 8 show the frictional force of the grip tabs used (Table on page 7) and the tearing sustained by the adhesive strips having the grip tabs (Table on page 8). Thus, for example, it will be understood that in example "E", wherein the grip tabs had a very high frictional force, no tearing occurred during redetachment. In Examples A & B, by contrast, where the frictional force of the grip tabs was less than that specified in the claims, 35 % of the tests in example A resulted in tearing and 65% of the tests in example B

resulted in tearing.

Furthermore, the results tabulated in the tables on pages 7 and 8, while demonstrating the advantages of the invention over the prior art, are by no means the only source of enablement in the specification. Those skilled in the art reading the entire specification, in the light of their own skills and experience, will certainly be enabled to practice the invention. In the event that the Examiner disagrees with this, he is respectfully asked to point out which part or parts of the invention he believes those skilled in the art will not be able to practice.

The objection to the specification and the rejection of Claims 1-10 under 35 U.S.C. 112, first paragraph, should now be withdrawn.

Claims 1-5 and 10 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al '012. The Examiner sees in the Lühmann reference what appears to him to be a substantially identical adhesive film strip having a grip tab made from the same materials as those of the present invention. The Examiner contends that the static frictional forces would be inherent.

The Examiner has not pointed to anything that would support his contention that the static frictional forces would be inherent. As can be seen from Examples B and C on pages 7 and 8 of Applicants' specification, two different silicone varnishes had markedly different static frictional forces; one having a static frictional force of only 20 whereas the other had a static frictional force of 210.

Nowhere in the reference cited is there any hint of any benefits to be achieved by providing grip tabs having a certain static frictional force, as recited in Applicants' claims. It should be noted that the "grip tab regions" the Examiner refers to as being mentioned at page 6 of Applicants' specification are grip tab regions which must be "modified by treating" (see page 5, last paragraph).

Thus, the Examiner has not shown anything in the prior art that would teach or suggest redetachable adhesive strips having grip tabs which have the static frictional forces recited in Applicants' claims, and the rejection of Claims 1-5 and 10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al '012 should now be withdrawn.

Claims 6-9 stand rejected under 35 U.S.C. 103(a) as obvious over Lühmann et al '012 taken individually or in view of Lühmann '932.

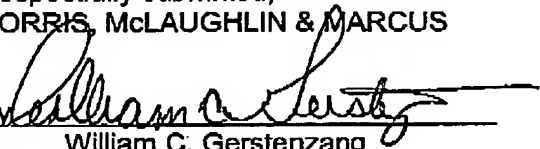
The unobviousness of Applicants' claims over Lühmann '012 individually has been shown above. The addition of Lühmann '932 does not overcome any of the differences pointed out above. The grip tab elements the Examiner refers to in the '932 reference appear to be coated with a release agent on the adhesive side only, and nothing is taught or suggested about providing said grip tabs with any minimum amount of static frictional force. Although the Examiner mentions the word "silicone", Applicants have shown that two different silicone compounds can have markedly different static frictional forces (i.e., Applicants' Experiments B & C). The presence of the word "silicone" in Lühmann '932 does not in any way suggest anything about providing grip tabs having specified degrees of frictional forces. Therefore neither Lühmann '012 taken individually nor any combination of Lühmann

'012 with Lühmann '932 could possibly lead to the present invention, and the rejection of Claims 6-9 under 35 U.S.C. 103(a) as obvious over Lühmann et al '012 taken individually or in view of Lühmann '932 should now be withdrawn.

In view of the present remarks it is believed that claims 1-10 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

Respectfully submitted,  
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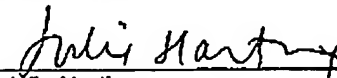
  
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Date September 12, 2003

OFFICIAL

## PATENTABILITY

2173.05(h)

commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

*Ex parte Markush* sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See *Ex parte Head*, 214 USPQ 551 (Bd. App. 1981); *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931).

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship; and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for

Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (MPEP § 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

#### Subgenus Claim

Genus, subgenus, and Markush-type claims, if properly supported by the disclosure, are all acceptable ways for applicants to claim their inventions. They provide different ways to present claims of different scope. Examiners should therefore not reject Markush-type claims merely because there are genus claims that encompass the Markush-type claims.

See also MPEP § 608.01(p) and § 715.03.

See MPEP § 803.02 for restriction practice re Markush-type claims.

## II. "OR" TERMINOLOGY

Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of"; "at least one piece"; and "iron, steel or any other magnetic material."

## III. "OPTIONALLY"

An alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term "optionally." In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language "containing A, B, and optionally C" was considered acceptable alternative language because there was no ambiguity as to which